

## REMARKS

Claims 1-37 are pending in the application. Claims 1, 8, 10, 17, 19, 26, 28, and 36 have been amended to correct minor informalities in the claims.

The Specification has been amended to correct the Cross Reference to Related Application section. By this amendment, the actual priority date has not been changed. Additionally, United States Patent Applications incorporated by reference were re-identified by their Application Serial Number. No new matter is added. If the Patent Office finds any additional errors, the Examiner is kindly invited to contact the undersigned Attorney at (402) 496-0300 to facilitate prosecution of the application.

### *Claim Objections*

The Patent Office objected to claims 10 and 28 due to informalities. Claims 10 and 28 have been amended to correct the informalities identified.

### *Claim Rejections - 35 USC § 112*

The Patent Office rejected claims 1-37 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Patent Office found that terms within claims 1, 8, 10, 17, 19, 26 and 28 lacked proper antecedent basis due to informalities within the claims. Claims 1, 8, 10, 17, 19, 26 and 28 have been amended to correct the informalities resulting in the rejection.

### *Claim Rejections – 35 USC § 103*

The Patent Office rejected claims 1-37 under 35 U.S.C. § 103(a) as being unpatentable over Goshey et al., U.S. Patent No. 6,205,527 (Goshey) in view of Fletcher et al., U.S. Patent No. 6,009,274 (Fletcher). Applicant respectfully traverses this rejection for the following reasons.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. MPEP § 2143.03 citing *In re*

*Ryoka*, 180 U.S.P.Q. 580 (C.C.P.A. 1974). *See also In re Wilson*, 165 U.S.P.Q. 494 (C.C.P.A. 1970). As noted by the Patent Office, neither Goshey nor Fletcher, either alone or in combination, disclose, teach or suggest the use of a restore medium capable of being read by an information handling system, wherein the restore medium includes a program of instructions for initiating a connection with a network storage medium over a network as variously claimed in independent claims 1, 10, 19 and 28. Nevertheless, to overcome this deficiency in the references, the Patent Office argues that

since a connection [with a network] is made, and it is done on a computer, there must exist a set of instructions that initiate the connection to the network storage medium.

However, even assuming this argument is correct, there still exists no teaching or suggestion from the prior art for providing a restore medium having such a set of instructions for use in restoring an information handling system (e.g., a computer), as presently claimed.

Further, there exists no reason, suggestion, or motivation from the prior art for modifying the teaching of Goshey or Fletcher to achieve Applicant's invention. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art suggests the desirability of the combination. MPEP § 2143.01. Further, the Patent Office must consider the claimed invention "as a whole" and must put aside knowledge of Applicant's disclosure in reaching a determination of obviousness. MPEP § 2141.02. The Patent Office argues that

it would have been obvious to one of ordinary skill in the art at the time of the invention to access a restore medium and load a set of software capable of returning a computer system to an operational state, as taught by Goshey, and furthermore, to access a network storage medium and receive a second set of software components suitable for updating the first set of software components, as taught by Fletcher, since this would allow a system not only to fully restore itself to an operational state, but to be updated with the newest possible drivers and updates available.

Applicant respectfully disagrees. Goshey is directed to an intelligent backup system for backing up selected data from a host computer's main storage drive to prevent loss of data or user productivity using a peripheral storage device connected to the computer

system. Fletcher, on the other hand, is directed to a method and apparatus for automatically updating software components in one or more agents (end system) in a network. As noted by the Patent Office, Goshey does not discuss initiating a connection with a network storage medium over a network, and thus provides no motivation for such a connection. Similarly, Fletcher does not address the use of a restore medium and thus provides no motivation for providing a restore medium. Finally, as argued above, neither reference teaches or suggests providing a restore medium having a set of instructions for initiating connection to a network storage medium for restoring an information handling system (e.g., a computer). Consequently, neither Goshey nor Fletcher may be relied upon to furnish motivation for their combination. Furthermore, the Patent Office has provided no other motivation for their combination other than to describe advantages provided by the current invention. Absent such motivation, it is believed that the Examiner has impermissibly attempted to use the teaching of Applicant's specification to modify the Goshey and Fletcher references to achieve Applicant's claimed invention, and it is requested that the rejection under 35 U.S.C. § 103 be withdrawn. MPEP § 2142; *In re Zurko*, 111 F.3d 887, 42 USPQ2d 1476 (Fed. Cir. 1997); *In Re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990); *In re Laskowski*, 871 F.2d 115, 10 USPQ2d 1397 (Fed. Cir. 1989).

Accordingly, it is respectfully submitted that a *prima facie* case of obviousness of claims 1-37 has not been established. Withdrawal of the rejections of these claims under 35 U.S.C. § 103 is therefore respectfully requested.

### CONCLUSION

The application is respectfully submitted to be in condition for allowance of all claims. Accordingly, notification to that effect is earnestly solicited.

Respectfully submitted,  
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